IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF MISSISSIPPI
WESTERN DIVISION

JERRY HATCHETT — PLAINTIFF

vs. — No. 3:99CV68-D-B

LIPENWALD, INC. d/b/a
NATIONAL TV BARGAINS — DEFENDANT

OPINION

Presently before the court is the Plaintiff's motion for summary judgment. Upon due consideration, the court finds that the motion should be granted in part and denied in part.

A. Factual Background

In the fall of 1994, Jerry Hatchett, along with his sister-in-law, conceived the idea of a device that allows a person to self-braid hair. They sought to patent the device and, on November 19, 1996, were issued United States Patent No. 5,575,297 (the '297 patent) by the United States Patent and Trademark Office.

In 1996, Hatchett became aware of potentially infringing hair braiding devices that were being marketed and sold. One of those devices, the "Braid Master," was being marketed and sold by Lipenwald, Inc., a Connecticut mail order company.

On May 26, 1999, Hatchett filed this suit, alleging, *inter alia*, that Lipenwald's actions infringed the '297 patent. Hatchett then, on June 27, 2000, moved for summary judgment on the following issues, pursuant to Rule 56 of the Federal Rules of Civil Procedure:

(1) the validity of the '297 patent;

(2) the infringement of the '297 patent by Lipenwald's sale of the Braid Master product;

(3) the intentional nature of Lipenwald's alleged infringement; and

(4) that Hatchett is entitled to treble damages at trial as well as an award of attorney's fees.

B. Summary Judgment Standard

A party is entitled to summary judgment "if the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no

genuine issue as to any material fact and that the moving party is entitled to judgment as a matter of law." Fed. R. Civ. P. 56(c). On a motion for summary judgment, the movant has the initial burden of showing the absence of a genuine issue of material fact. Celotex Corp. v. Catrett, 477 U.S. 317, 325, 106 S. Ct. 2548, 2554, 91 L. Ed. 2d 265 (1986). Under Rule 56(e) of the Federal Rules of Civil Procedure, the burden then shifts to the non-movant to "go beyond the pleadings and by...affidavits, or by the 'depositions, answers to interrogatories, and admissions on file,' designate 'specific facts showing that there is a genuine issue for trial.'" Celotex Corp., 477 U.S. at 324. That burden is not discharged by "mere allegations or denials." Fed. R. Civ. P. 56(e).

While all legitimate factual inferences must be viewed in the light most favorable to the non-movant, Rule 56(c) mandates the entry of summary judgment "against a party who fails to make a showing sufficient to establish the existence of an element essential to that party's case, and on which that party will bear the burden of proof at trial." Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 255, 106 S. Ct. 2505, 2513, 91 L. Ed. 2d 202 (1986); Celotex Corp., 477 U.S. at 322. Before finding that no genuine issue for trial exists, the court must first be satisfied that no reasonable trier of fact could find for the non-movant. Matsushita Elec. Indus. v. Zenith Radio Corp., 475 U.S. 574, 587, 106 S. Ct. 1348, 1356, 89 L. Ed. 2d 538 (1986).

C. Discussion

1. Validity of the '297 Patent

United States Patents are presumed valid and may only be deemed invalid by clear and convincing evidence. 35 U.S.C. § 282 (2000); Finnigan Corp. v. International Trade Comm'n, 180 F.3d 1354, 1365 (Fed. Cir. 1999). Here, Lipenwald did not plead invalidity as a defense to Hatchett's infringement action. Further, Lipenwald does not presently dispute the validity of the '297 patent. As such, the court finds that no genuine issue of material fact exists as to patent validity, and Hatchett is entitled to judgment as a matter of law on this issue.

2. Infringement of the '297 patent by Lipenwald's Sale of the Braid Master

A precursory glance at the Braid Master confirms that it is virtually identical to the device depicted by the '297 patent, and the court finds that the Braid Master clearly infringes upon the '297 patent.

An infringement analysis entails two steps:

(1) determining the meaning and scope of the patent claims asserted to be infringed; and

(2) comparing the properly construed claims to the device accused of infringing.

Markman v. Westview Instruments, Inc., 52 F.3d 967, 976 (Fed. Cir. 1995) (en banc), aff'd, 517 U.S. 370, 116 S.Ct. 1384, 134 L. Ed. 2d 577 (1996). If the accused product falls clearly within one or more claims of the patent, infringement must be found. Graver Tank & Mfg. Co. v. Linde Air Prods. Co., 339 U.S. 605, 607, 70 S.Ct. 854, 855, 94 L. Ed. 2d 1097 (1950).

In determining the meaning and scope of the '297 patent's claims, the court need only refer to the straightforward language of the claims themselves:

Claim 1 of the '297 patent claims:

> A hair styling device providing means for independently retaining a plurality of separate sections of hair, comprising a rigid frame assembly comprising a rigid base with a plurality of elongated rigid members adjacently joined to and arising from said rigid base in such a manner that slots are formed between the adjacent elongated members, each of said slots being of sufficient height and width to accommodate and retain a section of hair containing multiple strands of hair, said section consisting of a sufficient number of strands of hair as to be suitable for braiding, wherein said slots contain adjacent resilient surfaces in close proximity to each other, thereby enhancing the ability of said device to retain said sections of hair.

Claim 2 of the '297 patent claims:

> The device of claim 1 wherein said resilient surfaces are constructed from foam rubber.

Claim 3 of the '297 patent claims:

> The device of claim 1 wherein said resilient surfaces are constructed from materials other than foam rubber, while said materials exhibit similar physical properties to that of foam rubber, enabling said materials to perform the same functions within said device as would foam rubber.

Claim 5 of the '297 patent claims:

> A generally hand-shaped hair styling device providing means for independently retaining a plurality of separate sections of hair, comprising a rigid frame assembly comprising a curved rigid base with a plurality of adjacent elongated rigid members joined to and arising in a perpendicular manner from said curved rigid base in such a manner that slots are formed between the adjacent elongated members, each of said slots being of sufficient height and width to accommodate and retain a section of hair containing multiple strands of hair, said section consisting of a sufficient number of strands of hair as to be suitable for braiding, wherein said slots contain adjacent resilient surfaces in close proximity to each other, thereby enhancing the ability of said device to retain said sections of hair.
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> Claim 6 of the '297 patent claims:
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> The device of claim 5 wherein said resilient surfaces are constructed from foam rubber.
>
> Claim 7 of the '297 patent claims:
>
> The device of claim 5 wherein said resilient surfaces are constructed from materials other than foam rubber, while said materials exhibit similar physical properties to that of foam rubber, enabling said materials to perform the same functions within said device as would foam rubber.

In comparing the above claims to the Braid Master itself, the court finds that the Braid Master unquestionably infringes the '297 patent because it falls clearly within claims 1 and 5, as well as either claims 2 and 6 or claims 3 and 7.[1] Moreover, Lipenwald does not seriously contest the issue of infringement. As such, the court finds no genuine issue of material fact exists, and summary judgment shall be granted in favor of Hatchett as to infringement.

3. Willfulness

A finding of willfulness requires the fact finder to find, by clear and convincing evidence, "that the infringer acted in disregard to the patent . . . [and] had no reasonable basis for believing it had a right to do the acts." Stickle v. Heublin, Inc., 716 F.2d 1550, 1565 (Fed. Cir. 1983).

Here, the court finds that genuine issues of material fact exist as to whether Lipenwald willfully infringed the '297 patent, and this issue shall be submitted to a jury. As such, the court

[1]Claims 2 and 6 specify that the resilient surfaces between the slots are constructed of foam rubber. Claims 3 and 7 specify that the resilient surfaces between the slots are constructed of materials other than foam rubber, but which exhibit similar characteristics and perform the same functions as foam rubber. Thus, the Braid Master may infringe either Claims 2 and 6 or Claims 3 and 7, but not both.

finds that Hatchett has failed to show that he is entitled to judgment as a matter of law on this issue. In any event, the court has the discretion, which it exercises here, to allow this issue to proceed to trial. See Liberty Lobby, Inc., 477 U.S. at 255 ("Neither do we suggest ... that the trial court may not deny summary judgment in a case where there is reason to believe that the better course would be to proceed to a full trial."). Hatchett's motion for summary judgment on the issue of willfulness, therefore, shall be denied.

4. Treble Damages and Attorney's Fees

When a defendant has willfully infringed a patent, the court may "increase the damages up to three times the amount found or assessed." 35 U.S.C. § 284 (2000). While a finding of willful infringement alone may be enough to justify an award of enhanced damages, the court here has ruled that whether Lipenwald willfully infringed the '297 patent is an issue of fact to be decided by a jury. As such, the court declines, at this juncture, to state as a matter of law that Hatchett is entitled to an award of enhanced damages. Hatchett's motion for summary judgment as to an award of enhanced damages, therefore, shall be denied.

A court is to award attorney's fees for patent infringement only in "exceptional" cases. 35 U.S.C. § 285 (2000). While a finding of willful infringement may equate to exceptional circumstances and justify the granting of attorney's fees, the court here has ruled that the question of Lipenwald's willfulness and intent are questions of fact to be decided by a jury. See Del Mar Avionics, Inc. v. Quinton Instrument Co., 836 F.2d 1320, 1329 (Fed. Cir. 1987) (finding of willful infringement is sufficient to support award of attorney's fees). As such, the court cannot, at this juncture, rule that this is an exceptional case justifying an award of attorney's fees. Hatchett's motion for summary judgment as to an award of attorney's fees, therefore, shall be denied.

D. Conclusion

In sum, the court shall grant Hatchett's motion for summary judgment as to patent validity and infringement. In all other respects, the motion shall be denied.

A separate order in accordance with this opinion shall issue this day.

This the ____day of September 2000.

_____
United States District Judge

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ORDER

Pursuant to an opinion issued this day, it is hereby ORDERED that

(1) the Plaintiff's motion for summary judgment (docket entry 34) is GRANTED IN PART and DENIED IN PART.

(2) The motion is GRANTED as to the validity of United States Patent No. 5,575,297;

(3) the motion is GRANTED as to Lipenwald's infringement of United States Patent No. 5,575,297;

(4) the motion is DENIED in all other respects.

SO ORDERED, this the ____day of September 2000.

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United States District Judge